

Remarks

The Office Action dated July 21, 2010, notes that claims 6-7 and 16-17 are no longer objected to as allowable subject matter; claim 9 is objected to due to informalities; claims 1-8 and 10-18 stand rejected under 35 U.S.C. 103(a) over Thierry Roz (WO 99/60510) in view of Shigyo (U.S. Patent No. 6,430,209) and further in view of Raphaeli (U.S. Patent Pub. 2007/0109099); claims 20-26 stand rejected under 35 U.S.C. § 103(a) over the '510 reference in view of the '099 reference; and claims 9 and 19 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten. In the following discussion, Applicant does not acquiesce in any regard to averments in the Advisory Action or the Office Actions of record (unless Applicant expressly indicates otherwise).

Applicant appreciates the indication of allowable subject matter in claims 9 and 19. Applicant has amended claims 9 and 19 to incorporate the limitations of the claims from which they depend, and accordingly believes claims 9 and 19 to be in condition for allowance.

Regarding the objection to claim 9, Applicant was unable to find both the objection to language "a synchronization circuit" in claim 9 and the suggested language in claim 19. Notwithstanding, Applicant has amended claim 9. Applicant therefore requests the objection to claim 9 be removed.

For this claim 9 and the issue for claims 20-26, the Examiner may have been looking at an earlier set of claims.

The current rejections of claims 20-26 include assertions of correspondence to claim limitations not found in claims 20-26. For example, on page 11 of the current Office Action, the rejection appears to quote language directed to "at least one of the received commands does not contain synchronizing information for effecting synchronization of the RFID device with the reading device." However, claim 20 does not include a limitation that one or the other of the received commands not include sync information but instead includes two separate limitations, one that "the repeat command not [contain] the synchronization information" and a second that "the confirm command not [contain] the synchronization information." Because the Office Action fails to assert correspondence to these aspects and instead attempts to assert correspondence to a

limitation not found in the claims, the § 103(a) rejection of claims 20-26 is improper and should be withdrawn.

Applicant traverses the § 103(a) rejection of claims 20-26 because the cited ‘510 reference either alone or in combination with the ‘099 reference lacks correspondence to the claimed invention. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including aspects regarding, *e.g.*, a confirm command signal not containing synchronization information. More specifically, the Office Action acknowledges that the ‘510 reference does not teach claimed aspects directed to the MUTE signal (the asserted confirm command signal) not containing synchronization. Further, the ‘099 reference appears to teach an interrogation signal that does not contain synchronization information. However, the interrogation signal does not perform the function of the confirm command, and therefore cannot correspond to the claimed confirm command not containing synchronizing information. Because neither reference teaches aspects of the claimed invention directed to a confirm command signal not containing synchronization information, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. Accordingly, the § 103(a) rejection of claims 20-26 fails and Applicant requests that it be withdrawn.

Applicant respectfully traverses the § 103 rejection of claims 1-8 and 10-18 because the cited references teach away from the Office Action’s proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (‘510) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007). (“[W]hen the prior art teaches away from combining certain known elements,”). Applicant submits that the combination would render the invention inoperable because the Office Action’s asserted hypothetical embodiment includes shutting off control logic 302 when it is detected that the transponder TR_i is in sync with the reading device. *See* page 5 of the Office Action. However, “modulator 306 is controlled by a control logics 302 coupled to memory 304.” Page 10 of the ‘510 reference. If the control logics 302 is off it cannot control the modulator 306, and transmission of the encoding data will not occur. For at least these reasons the asserted hypothetical combination of the ‘510 reference, the ‘209 reference

and the '099 reference is inoperable. Under M.P.E.P. § 2143.01, the rejections cannot be maintained.

Applicant respectfully reminds the Examiner that any subsequent rejection of claims 20-26 including assertions of correspondence to the claim limitations not currently discussed in the Office Action would constitute new grounds of rejection. Accordingly, any rejection that addresses the above mentioned claim limitations cannot properly be made final. *See* M.P.E.P. § 706.07(a) ("Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement."). The policy behind the inability to make final in the presence of new grounds of rejection is to insure that the Applicant has adequate time to respond to the rejections, and to prepare the record for appeal, if necessary.

In view of the above, Applicant believes that each of the rejections is improper and should be withdrawn and that the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney/agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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